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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/633,351 08/04/00 ULLMAN

C 4247.05

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TM02/0521

EXAMINER

VU, V

ART UNIT

PAPER NUMBER

2154

DATE MAILED:

05/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/633,351

Applicant(s)

Ullman et al

Examiner

V. Vu

Group Art Unit

2154

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 12-8-00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-159 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-6, 11-159 is/are rejected.
- ☒ Claim(s) 7-10 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

**DETAILED ACTION**

**Art Rejections:**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>o</sup> of this title before the invention thereof by the applicant for patent.

2. Claims 1-6, 11-26, 28-37, 39-74, 76-85, 87-109, 111-117, 119-159 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Palmer et al, hereafter Palmer, U.S. pat. No. 5,905,865.

Palmer discloses a system and method for providing media/broadcast programming and online services to user comprising:

a) a receiver for receiving video/audio programming signal from one of plurality of sources including radio, satellite, cable, fiber optics, DVD, etc., (see col 8, lines 5-13),

b) means for extracting at least one address embedded in the signal (col 8, lines 13-19),

- c) a browser for using the address to automatically establish a communication path with one of the online information providers (col 5, lines 32-34 and col 6, lines 10-13),
- d) a program for automatically retrieving information from the online service provider (col 6, line 47 - col 7, line 18),
- e) a display device for presenting the information content to the user, e.g., information on an artist, live chats and on-line ordering, in concurrence with the programming (see col 5, lines 22-38 and col 6, lines 49-55).

Palmer also teaches using user profiles to select programming and/or content information (see col 7, lines 19-45).

Per claims 125 and 147, Palmer further teaches using a timer for controlling/switching display of specific information content in synchronism with the program (see col 6, lines 39-42).

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability

shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103<sup>o</sup> and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 27, 38, 75, 86, 110 and 118 are rejected under 35 U.S.C. § 103 as being unpatentable over Palmer and further in view of Dedrick, U.S. pat. No. 5,710,884.

Palmer's teachings are still applied as discussed in item 2 above. Palmer does not teach monitoring activities of each user during the program duration, e.g., user clicks. Such monitoring of user's computer and user's activity for marketing purpose is well-known in the art as disclosed by Dedrick (see Dedrick's col 5, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Palmer with Dedrick's

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teaching of data monitoring because it would have enabled the server to compile a more complete user profile for use by the advertisers.

**Allowable Subject Matter:**

6. Claims 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion:**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



**VIET D. VU  
PRIMARY EXAMINER**

Art Unit 2154  
5/16/01